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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,709	08/07/2001	Martin Sicilaff	200400111-1	1241

22879 7590 02/23/2007

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EXAMINER	
NGUYEN, DUSTIN	
ART UNIT	PAPER NUMBER
2154	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/922,709	SIELAFF ET AL.	
	Examiner	Art Unit	
	Dustin Nguyen	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 3 and 6-23 are presented for examination. Claim 3 is withdrawn from consideration.

Election/Restrictions

2. Applicant's election without traverse of Invention II, claims 6-23 in the reply filed on 11/27/2006 is acknowledged.

Response to Arguments

3. Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive.

4. As per remarks, Applicants' argued that (1) Roth does not teach "wherein said user prompt leads to a sale" as recited in claim 6.

5. As to point (1), Roth discloses a system for displaying advertisement to viewer [Figure 1; Abstract; and col 2, lines 1-9]. The advertisements are provided by Ad space providers (seller) [i.e. advertisement or user prompt leads to a sale] [col 1, lines 50-54; and col 9, lines 15-16]. In addition, as defined by the Merriam-Websters Collegiate Dictionary, advertise means

to call pubic attention by emphasizing desirable qualities so as to arouse a desire to buy [i.e. user prompt leads to a sell]. As such, Roth teaches the claimed language as written, rendering the claimed unpatentable over the prior art of record.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner recognized that Roth does not provide the rules causes and the optional rules causes as claimed in claim 6, Examiner relied on the second reference, Gross, to point out the required and optional rule, as mentioned in the previous Office Action, wherein it would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth and Gross because Gross' teaching of optional and required rules would provide a flexible, efficient, event-driven and conditional rule-based system which can be transparently implemented for use [Gross, col 2, lines 40-43].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 6-9, 11-14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. [US Patent No 6,285,987], in view of Gross et al. [US Patent No 5,283,856].

9. As per claim 6, Roth discloses the invention substantially as claimed including a rules evaluation system for a user's computer comprising:

a rules-based agent [i.e. bidding agent] [30A, 30B and 30Z, Figure 1; and col 3, lines 59-col 4, lines 6] having a plurality of rule clauses for evaluating data [i.e. target criteria] [col 1, lines 50-54; col 2, lines 28-31];

at least one targeted advertising trigger having functionality to notify the rules-based agent to begin evaluating [i.e. evaluate view-op] [col 2, lines 11-19 and lines 54-58; and col 12, lines 11-39];

a plurality of data providers to provide data for evaluation [i.e. advertisers] [col 1, lines 55-64]; and

at least one action for providing information to a user based upon the evaluated data [i.e. sends appropriate advertisement from data base to browser] [col 4, lines 42-44; and col 5, lines 32-37], and wherein at least one of said at least one action comprises communicating with said user by displaying a user prompt associated with said target advertising triggers [i.e. advertisements display for particular viewer] [Abstract; col 2, lines 1-9; and col 6, lines 33-40], and wherein said user prompt leads to a sale [i.e. Ad space provider (seller) or advertisement] [col 3, lines 51-55; col 8, lines 1-4; and col 9, lines 15-16].

Roth does not specifically disclose

wherein the rules clauses comprises one or more required rules clauses and one or more optional rules clauses; and

wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied.

Gross discloses

wherein the rules clauses comprises one or more required rules clauses [i.e. required syntax] [col 2, lines 21-29; and Appendix I, lines 1-40] and one or more optional rules clauses [i.e. optional Form, Folder or Time] [Appendix I, col 19, lines 54-67 and col 21, lines 50-55]; and

wherein an action is performed provided all of the required rules clauses and at least one of the optional rules clauses are satisfied [i.e. when satisfied, the conditions cause actions to be taken] [col 6, lines 44-47; and col 8, lines 35-41].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth and Gross because Gross' teaching of required and optional rules would provide a flexible, efficient, event-driven and conditional rule-based system which can be transparently implemented for use [Gross, col 2, lines 40-43].

10. As per claim 7, Roth discloses wherein the trigger is based upon user activity [i.e. previous viewing habits] [col 8, lines 65-67].

11. As per claim 8, Roth discloses wherein the trigger is based upon time [col 4, lines 63-col 5, lines 4].

12. As per claim 9, Roth discloses wherein the trigger is based upon computer online activity [i.e. which sites each viewer has previously accessed] [col 9, lines 31-35].

13. As per claim 11, Roth discloses wherein the trigger is based upon software present in the computer [i.e. operating system or browser type] [col 1, lines 50-54; and col 8, lines 20-28].

14. As per claim 12, Roth discloses wherein rule clauses can be added dynamically [col 5, lines 38-63].

15. As per claim 13, Roth discloses wherein triggers can be added dynamically [i.e. specified data can be introduced into data base 16B in a number of ways] [col 18, lines 44-lines 65].

16. As per claim 14, Roth discloses wherein data providers can be added dynamically [i.e. identifies every active advertiser] [col 9, lines 38-39; and col 10, lines 21-29].

17. As per claim 22, Roth discloses wherein the action is a link to a related website presented to the user [col 8, lines 1-4].

18. Claims 10, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. [US Patent No 6,285,987], in view of Gross et al. [US Patent No 5,283,856], and further in view of Binder [US Patent No 6,513,052].

19. As per claim 10, Roth and Gross do not specifically disclose wherein the trigger is based upon hardware present in the computer. Binder discloses wherein the trigger is based upon hardware present in the computer [i.e. current hardware configuration] [Abstract; and col 5, lines 25-32]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Binder because Binder's teaching of current hardware configuration would enable to select and present advertisement that has a high correlation to the user's needs, behavior, and preferences, thereby increasing the probability of generating revenue from the advertising [Binder, col 1, lines 49-54].

20. As per claim 17, Roth and Gross do not specifically disclose wherein the data provider detects a speed of the user's computer hard drive. Binder discloses wherein the data provider detects a speed of the user's computer hard drive [Abstract; col 1, lines 59-64; col 3, lines 21-26; and col 4, lines 24-30]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Binder because Binder's teaching of current hardware configuration would enable to select and present advertisement that has a high correlation to the user's needs, behavior, and preferences, thereby increasing the probability of generating revenue from the advertising [Binder, col 1, lines 49-54].

21. As per claim 18, Roth and Gross do not specifically disclose wherein the data provider detects an amount of memory installed on the user's computer. Binder discloses wherein the data provider detects an amount of memory installed on the user's computer [col 5, lines 28-32]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Binder because Binder's teaching of current hardware configuration would enable to select and present advertisement that has a high correlation to the user's needs, behavior, and preferences, thereby increasing the probability of generating revenue from the advertising [Binder, col 1, lines 49-54].

22. As per claim 19, Roth and Gross do not specifically disclose wherein the data provider detects downloaded software. Binder discloses wherein the data provider detects downloaded software [col 4, lines 30-39; and col 5, lines 61-col 6, lines 11]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Binder because Binder's teaching of current software configuration would enable to select and present advertisement that has a high correlation to the user's needs, behavior, and preferences, thereby increasing the probability of generating revenue from the advertising [Binder, col 1, lines 49-54].

23. Claims 15, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. [US Patent No 6,285,987], in view of Gross et al. [US Patent No 5,283,856], and further in view of Klayh [US Patent Application No 2003/01].

24. As per claim 15, Roth and Gross do not specifically disclose wherein actions can be added dynamically. Klayh discloses wherein actions can be added dynamically [i.e. advertising has been displayed broadcast or narrowcast] [paragraph 0003]. It would have been to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Klayh because Klayh's teaching would enable a system for precision distribution of advertising to particular persons or locations [Klayh, paragraph 0002].

25. As per claim 20, Roth and Gross do not specifically disclose wherein the action is a pop-up box displayed to the user. Klayh discloses disclose wherein the action is a pop-up box displayed to the user [paragraphs 0043 and 0044]. It would have been to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Klayh because Klayh's teaching would enable a system for precision distribution of advertising to particular persons or locations [Klayh, paragraph 0002].

26. As per claim 21, Roth and Gross do not specifically disclose wherein the action is an e-mail sent to the user. Klayh discloses wherein the action is an e-mail sent to the user [paragraph 0077]. It would have been to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Klayh because Klayh's teaching would enable a system

for precision distribution of advertising to particular persons or locations [Klayh, paragraph 0002].

27. As per claim 23, Roth and Gross do not specifically disclose wherein the action is a video displayed on the user's computer. Klayh discloses wherein the action is a video displayed on the user's computer [paragraphs 0014 and 0172]. It would have been to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Klayh because Klayh's teaching would enable a system for precision distribution of advertising to particular persons or locations [Klayh, paragraph 0002].

28. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. [US Patent No 6,285,987], in view of Gross et al. [US Patent No 5,283,856], and further in view of Dentel et al. [US Patent No 7,062,451].

29. As per claim 16, Roth and Gross do not specifically disclose wherein the data provider detects a level of ink in the user's printer. Dentel discloses wherein the data provider detects a level of ink in the user's printer [i.e. detection of a low-ink status in printer] [Figure 3; and col 5, lines 14-16]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Roth, Gross and Dentel because Dentel's teaching of detecting ink status would enable a user of a processor system to purchase products which are

compatible for use with a particular type of component of the processor system [Dentel, col 1, lines 4-10].

30. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3970.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).